

REMARKS

Claims 1 – 13 remain pending in this application.

I. The Rejection

Claim 1 – 3 and 8 - 10 have been rejected under 35 USC §102(e) as being anticipated by Sartain et al. (US 6,169,747).

Claims 4 - 7 have been rejected under 35 U.S.C. § 103 (a) as unpatentable over Sartain in view of Sato et al (US 5,566,174).

Claims 11 and 13 have been rejected under 35 U.S.C. § 103 (a) as unpatentable over Sartain in view of Kostreski et al (US 5,734,589).

Claim 12 has been rejected under 35 U.S.C. § 103 (a) as unpatentable over Sartain in view of Horton (US 5,969,770).

2. The Response

Independent Claims 1 and 8 are proposed to be amended by re-arranging the order in which elements previously recited in the rejected claims are rearranged and subsequent references to such recited elements use the language “said” so as to make it more clear how these elements are inter-related. As will be pointed out below, this rearrangement of claim language should overcome the Examiner’s objections to the effect that Applicant is attempting to rely on unclaimed distinguishing features to overcome the references.

Specifically, in paragraph 7 of the Final Rejection, the Examiner states that, while

“Applicant argues there is no disclosure or suggestion in Sartain et al. of an input packet stream generator responsive to a variable output clock signal generator as is recited in the claims”,

“Examiner contends (the) disputed limitation is not in the claims”.

In order to demonstrate more clearly that Applicant’s claims (particularly, independent claims 1 and 8) do, in fact, recite “the disputed limitation”, Applicant has rearranged the order of the elements of each of independent claims 1 and 8, inserted the word “said” in certain instances and specifically added the word “variable” before “output clock signal” in instances where it was implied in the

earlier claims.

Specifically, in independent apparatus claim 1, the order of the last three elements of the claim (originally, (1) "an output packet stream generator ---", (2) "a variable output clock signal generator---" and (3) " a control signal generator--", has been reversed. Previous element (3) is now recited first, previous element (2) is now recited second and previous element (1) is now recited third in claim 1. In addition, as can be seen from the underlining and strikethrough notations in the presently submitted claims, "said" has been inserted before "status signal" and "control signal" and "said variable" has been inserted before "output clock signal" where these terms are repeated a second (or later) time in the claims.

It should be noted that original claim 1 did recite "a variable output clock signal generator" but, because of the order in which the claim elements were recited, it may not have been entirely clear to the Examiner that the "output clock signal" recited in those claims in connection with the "output packet stream" was, in fact, a "variable" output clock signal.

As amended, it should be clear that the (presently) last-recited element in claim 1 is "responsive to said variable output clock signal" and generates "said output packet stream in synchronism with said variable output clock signal".

It is respectfully submitted that there can be no doubt that this specifically recited element of the claims, as argued previously, is neither disclosed nor suggested by Sartain (or any of the other cited references). Therefore, withdrawal of the rejection of apparatus claims 1-7 and allowance thereof are respectfully requested.

It should also be noted that original claim 2 specifically recited this feature of the invention ("variable output clock signal generator").

Similarly, method claim 8 has been re-arranged and amended to make it clear that the recited "output packet stream" is generated "in response to and in synchronism with said variable output clock signal".

Since neither Sartain nor any of the other cited references disclose or suggest this feature, method claims 8 – 13 are also submitted to be allowable. It should be noted that dependent claim 9 as originally filed recited the variable

output clock signal.

It is respectfully submitted that these changes are for clarification and do not change the intended meaning of these claims. As such, it is respectfully requested that these changes be permitted at this time since they are believed to place the claims in condition for allowance, or, at least, in better condition for appeal, if the Examiner continues to take the position they are unpatentable. The claims as amended should not require any further search since the subject matter was presented in dependent claims as noted.

It is noted that, in order to anticipate a claim under 35 USC 102(e), the reference must teach every element of the claim. That is,

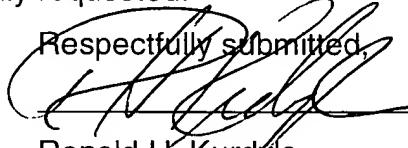
“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. V. Union Oil Co. of California, 814 F2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

“The identical invention must be shown in as complete detail as is contained in the ----claim.” Richardson v. Suzuki Motor Co., 868 F2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

“The elements must be arranged as required by the claim, but ----identity of terminology is not required.” In re Bond, 910 F2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Sartain does not meet this test.

Reconsideration and withdrawal of all rejections are respectfully requested in view of the amendments to the claims and the arguments presented above. Allowance of all pending claims 1 –13 are respectfully requested.

Respectfully submitted,


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